

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Yeong-Tae NO et al. : Confirmation No.: 8532

U.S. Patent Application No. 10/589,550 : Group Art Unit: 2617

Filed: July 3, 2007 : Examiner: Myron Wyche

For: Method and Apparatus of Transmitting Personal Information in Subscriber-Based Ringback Tone Service

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Dear Sir:

This request is being filed, in reply to the final Office Action mailed December 7, 2010, with a Notice of Appeal in compliance with 37 C.F.R. §41.31 and the fee set forth in 37 C.F.R. §41.20(b)(1). The review is requested for the reasons set forth below.

The following clear errors are found in the Examiner's rejection of claims 1, 3, 5, 6, 10, 14, 15, 19, 21 and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2007/0123311 to Kim et al. (hereinafter "Kim") in view of U.S. Patent Application Publication No. 2004/0120494 to Jiang et al. (hereinafter "Jiang").

The final Office Action concedes that Kim does not teach wherein the specific sound is generated by combining a subscriber information sound for specific information, which can identify a called subscriber or can represent the subscriber's character, with a common ringback tone replacement sound set by the called subscriber. The Office Action asserts that Jiang remedies these shortfalls of Kim. The analysis of the final Office Action is in clear error for the following reasons.

The Office Action asserts that the specific sound is generated by combining a subscriber information sound for specific information, which can identify a called subscriber or can represent the subscriber's character, with a common ringback tone replacement sound

set by the called subscriber, as recited in claim 1 and similarly recited in claims 10 and 19, is disclosed by Jiang at FIGS. 1, 2 and 4, and paragraphs [0018], [0025], [0064] and [0066].

Paragraph [0018] of Jiang discloses merely that the present invention allows the operator of a telecommunication network to deploy the user selected ring back tones, music clips, and announcements to a subscriber, that these techniques enhance existing intelligent network (IN) mechanisms, without violating the current and existing compliances, and that this functionality is applicable to both originating and terminating IN custom ringback services and can be combined with any current existing services, such as prepaid, VPN (virtual private network), or as a standalone postpaid IN based service.

The final Office Action asserts that paragraph [0018] of Jiang states combining custom ring back mechanisms. Paragraph [0018] has only one of combining that states “this functionality is applicable to both originating and terminating IN custom ringback services and can be combined with any current existing services, such as prepaid, VPN (virtual private network), or as a standalone postpaid IN based service. Thus, paragraph [0018] discloses combining this functionality (which corresponds to the functionality of user selected ring back tones, music clips, and announcements to a subscriber) with a virtual private network or a standalone postpaid IN based service. Neither of a virtual private network or a standalone postpaid IN based service, corresponds to any one of a subscriber information sound for specific information or a common ringback tone replacement sound set by the called subscriber. Virtual private networks and standalone postpaid IN based services are not sounds. Virtual private networks and standalone postpaid IN based services are types of network structure. Thus, paragraph [0018] would not have suggested combining a subscriber information sound for specific information with a common ringback tone replacement sound set by the called subscriber, as recited in claims 1 and similarly recited in claims 10 and 19. Thus, the Office Action appears to draw its conclusions regarding in particular paragraph [0018] of Jiang through the impermissible application of hindsight reasoning based on the road map provided by the Applicants’ application.

Paragraph [0019] of Jiang discloses “When the custom ringback mechanisms are used to support a terminating service, the calling party will hear the custom ringback tone, music clip, or announcement chosen by the terminating party as part of their terminating IN service. The custom ringback will be heard in place of the existing network-wide ringing tones currently heard today. When the custom ringback mechanisms are used to support an

originating service, the calling party will hear the custom ringback tone, music clip, or announcement chosen by the originating party as part of their originating service. The custom ringback will be heard in place of the existing network-wide ringing tones ordinarily provided by the service provider.” Thus, Jiang at paragraph [0019] discloses in any combination of the functionality of user selected ring back tones, music clips, and announcements to a subscriber with a virtual private network or a standalone postpaid IN based service correspond to the custom ringback being heard in place of the existing network-wide ringing tones, that is, replacing the existing network-wide ringing tones with a custom ringback. Paragraph [0019] of Jiang would not have suggested combining the existing network-wide ringing tones with a custom ringback because Paragraph [0019] of Jiang teaches replacing the existing network-wide ringing tones with a custom ringback. Thus, Paragraph [0019] of Jiang teaches away from combining more than one ringtone sound and paragraph [0019] would not have suggested combining a subscriber information sound for specific information with a common ringback tone replacement sound set by the called subscriber, as recited in claims 1 and similarly recited in claims 10 and 19.

Paragraph [0025] of Jiang discloses “the IP 116 provides audio and/or video information to MSC 104, which transmits this content back to calling party 108. The SCP 114 instructs the IP 116 which audio/video clip to play to the calling party thru the defined SCP114 and IP 116 interface. In another configuration, the messaging from the MSC 104 to the IP 116 could contain the specific audio/video clip to be played. The EP 116 is shown in a different functional box as SCP 114 (and also MSCs 102, 104 and 106), but it is understood that from a physical standpoint any of these functional units can be combined. Thus, paragraph [0025] of Jiang discloses combining functional units, that is, the home location register (HLR) 112, service control point (SCP) 114, and intelligent peripheral/intelligent voice recognition (IP/IVR) unit 116 of FIG. 1. None of the features disclosed in paragraph [0025] of Jiang correspond to a subscriber information sound for specific information or a common ringback tone replacement sound set by the called subscriber. Thus, paragraph [0025] of Jiang would not have suggested combining a subscriber information sound for specific information with a common ringback tone replacement sound set by the called subscriber as recited in claim 1 and similarly recited in claims 10 and 19.

Paragraph [0064] of Jiang discloses that the SCP sends a CONNECT with the standard DRA containing B's and the Generic Number contains an NQI value to allow the

MSC/SSP to recognize the call needs to support the Ringback Service mechanisms. Further, paragraph [0066] discloses that the IP/IVR sends an ARI (Assist Request Instruction, which is an IN message between the EP/IVR and the SCP) to the SCP, and the SCP sends a PA (Play Announcement, which is an IN message between the IP/IVR and the SCP) to the IP/IVR identifying which personalized Ringback to play. Thus, neither of paragraphs [0064] or [0066] of Jiang would have suggested combining any sounds because paragraphs [0064] and [0066] of Jiang merely disclose sending a Play Announcement to the IP/IVR identifying which personalized Ringback to play. Paragraphs [0064] or [0066] of Jiang would not have suggested playing any second ring tone sound. Accordingly, neither of paragraphs [0064] or [0066] would have suggested combining a subscriber information sound for specific information with a common ringback tone replacement sound set by the called subscriber as recited in claim 1 and similarly recited in claims 10 and 19.

FIG. 2 of Jiang discloses a flowchart showing a preferred method and FIG 4 is a block diagram with flow charts showing specific examples of the present invention. Neither of FIGS. 2 and 4 would have suggested combining a subscriber information sound for specific information with a common ringback tone replacement sound set by the called subscriber as recited in claim 1 and similarly recited in claims 10 and 19.

In view of the above, none of the portions of Jiang , alone or in combination, that are cited in the final Office Action would have suggested combining a subscriber information sound for specific information with a common ringback tone replacement sound set by the called subscriber as recited in claim 1 and similarly recited in claims 10 and 19. Therefore, the combination of Kim with Jiang would not have suggested the combination of all of the features recited in claims 1, 10 and 19. U.S. Patent No. 6,768,789 to Wilk et al., U.S. Patent Application Publication No. 2004/0203613 to Zhu et al. and U.S. Patent Application Publication No. 2002/0193125 to Smith do not remedy the shortfalls of Kim and Jiang

For the reasons presented above, a prima facie case of obviousness has not been established with respect to independent claims 1, 10 and 19. The dependent claims are considered patentable at least for the reasons advanced with respect to the respective independent claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,
LOWE HAUPTMAN HAM & BERNER, LLP

/Yoon S Ham/
Yoon S. Ham
Registration No. 45,307

Customer Number: 22429
1700 Diagonal Road, Suite 300
Alexandria, Virginia 22314
(703) 684-1111
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